BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

As rescanning documents *will not* correct images, please do not report the images to the Image Problem Mailbox.

protrusions 136" and 138" closer together. This increases the gripping force of the protrusion 136" and 138". The alternative lip stop 130" is shown as a "T".--

REMARKS

Claims 1-20 are pending and have been examined. Reexamination and reconsideration of the Application, as amended above, and in view of the remarks below, is requested.

The Specification and Drawings have been amended to address the informalities noted by the Examiner. No new matter is believed added. Corrected formal drawings will be filed upon allowance of the Application.

The Examiner has rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. 6,044,582) in view of Applicant's admission. The Applicant agrees with the Examiner that the Johnson reference does not disclose the clip design. The Johnson reference is directed to connecting a fish hook 32 at the end of a hollow rope 12. The hook is "[a] metal, either tin or stainless steel, or even possibly plastic safety pin type hook assembly 32 commonly found on fish stringers . . ." Johnson, column 2, lines 32-35. In Johnson, the free end of a hook is inserted through the fish's mouth and exits through the fish's gills. These type of hooks do not rely on a gripping force to hold a fish. The Johnson reference fails to teach or suggest the ability to retain a fish by applying a gripping force on the lip of a fish, as required by the present invention. Thus, Johnson is fundamentally different from the claimed invention in terms of structure and function. Moreover, there is nothing in the Applicant's admission that would suggest (1) the molded clip would be useful for holding fish, or (2) to add a rope to the clip.

In establishing a *prima facie* case of obviousness under 35 USC 103, it is incumbent upon the Examiner to provide a "clear and particular" showing of "actual evidence" of a

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701

TEL. 520.882.7623
FAX. 520.882.7643

suggestion, teaching, or motivation to combine references. In re Dembiczak, 50 USPQ 2d, 1614, 1617 (Fed. Cir. 1999). "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence." Id., citing McElmury v. Arkansas Power and Light Co., 995 F.2d 1576, 1578, 27 USPQ2d. 1129, 1131 (Fed. Cir. 1993) (internal quotations omitted).

In fact, in In re Dembiczak the Court of Appeals for the Federal Circuit recognized that "rigorous application" of the requirement for a showing of a teaching or motivation to combine references is the "best defense against the subtle but powerful attraction" of improper hindsight-based obvious analysis. Id.; See also, Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc., 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995) ("obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor"). This is especially true in cases where the ease with which the invention may be understood "may prompt one to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher." Id. citing W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

As the Examiner knows, a 35 USC § 103 rejection may stand only when the prior art would have provided both a suggestion of the claimed invention and an expectation of success to one of ordinary skill in the art at the time the invention was made. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

It is never appropriate to "pick and choose among individual elements of assorted prior art references to recreate the claimed invention" absent "some teaching or suggestion in the

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701

TEL. 520.882.7623
FAX. 520.882.7643

references to support their use in the particular claimed combination." Symbol Technologies, Inc. V. Opticon, Inc., 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991).

It is submitted that the Examiner has employed impermissible hindsight, and has applied the teachings of the present invention to the prior art to make out a case of obviousness. Such rejection is in error.

Therefore, independent claims 1 and 12 , and the several claims directly or ultimately dependent thereon, cannot be said to be obvious from the prior art.

It is believed that the application now is in order for allowance. Early and favorable action is respectfully requested.

Pursuant to 37 C.F.R. 1.121, attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE".

In view of the foregoing comments, it is submitted that Applicants' claimed invention is patentable.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,

Norman P. Soloway
Attorney for Applicant
Reg. No. 24, 315

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701

TEL. 520.882.7623
FAX. 520.882.7643

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on April 8, 2002, at Tucson, Arizona.

By Sharon McKniff

NPS:nm

HAYES SOLOWAY P.C.
130 W. CUSHING ST.
TUCSON, AZ 85701

TEL. 520.882.7623
FAX. 520.882.7643

MARKED COPY OF SPECIFICATION PARAGRAPH

SERIAL NO. 09/723,868

DOCKET: FANEUF 00.02

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Paragraph beginning at page 6, line 12 has been amended as follows:

Figure 5 shows a second embodiment of a clip 100". The clip 100" shows an alternative biasing member 116" and lip stop 130". The biasing member 116" is coupled to the ends of upper portions 106" and 108". Coupled to the biasing member 116" is a pair of protrusions 150A" and 150B". The protrusions 150A" and 150B" form an opening[[]]150". The opening 150" provides a convenient coupling location for a rope. When a force is exerted upward on the coupled rope, the force urges the upper portion 106" and 108" away from each other which urges protrusions 136" and 138" closer together. This increases the gripping force of the protrusion 136" and 138". The alternative lip stop 130" is shown as a "T".

MARKED COPY OF DRAWINGS

SERIAL NO. 09/723,868

DOCKET: FANEUF 00.02